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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 920

THEODORE C. GERNER, *Petitioner*

v.

MOOG INDUSTRIES, INC. *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE EIGHTH CIRCUIT

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CASES CITED

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Chemical Construction Corp. v. Jones & Laughlin Steel Corp., 311 F. 2d 367 (3rd Cir. 1962) 6, 7, 8
Ensten v. Simon Ascher Co., 282 U.S. 445 ..... 7, 8

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No.

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v.

MOOG INDUSTRIES, INC., *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE EIGHTH CIRCUIT

Petitioner, Theodore C. Gerner, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Eighth Circuit which held the Gerner patent No. 3,044,798 invalid.

OPINIONS BELOW

The opinion of the District Court for the Eastern District of Missouri, Eastern Division, (Record, Vol. I, pp. 138-150) is reported at 254 F.Supp. 969, 149 U.S.P.Q. 891 and is reprinted in Appendix A of this Petition, pp. 1a-13a. The opinion of the Court of Appeals for the Eighth Circuit (Record, Vol. III, pp. 1-7) is reported at 155 U.S.P.Q. 232 and is reprinted in Appendix B of this Petition, pp. 14a-19a.

JURISDICTION

The judgment of the Court of Appeals was entered on September 19, 1967, and rehearing was denied on November 6, 1967. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED FOR REVIEW

This is a patent infringement suit in which at most only claims 1, 4 and 5 of the Gerner patent were put in issue. The judgment entered by the District Court nevertheless held the Gerner patent invalid without regard to the claims in issue. The Court of Appeals affirmed. The questions presented are:

1. Whether a patent can be adjudicated invalid where only certain of the claims thereof are put in issue;

2. Whether, in considering the condition for patentability under 35 U.S.C. 103, this Court's opinion in *Graham* v. *John Deere Co.*, 383 U.S. 1, requires a specific determination of (a) the scope and content of the prior art; (b) the differences between such prior art and the patent claims in suit; and (c) the level of ordinary skill in the pertinent art.

STATUTES INVOLVED

35 U.S.C. 103. Conditions for Patentability: Non-Obvious Subject Matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. 253. Disclaimer

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. 288. Action for Infringement of a Patent Containing an Invalid Claim

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit.

STATEMENT OF THE CASE

Petitioner is one of the rapidly disappearing group of private citizens who individually have pioneered the development and commercialization of innovations in the American tradition. Petitioner's small,

privately owned company has survived in the jungle of automotive parts manufacture only through his inventive genius. Petitioner is the inventor and owner of some twenty odd patents granted by the United States Patent Office. (Record, Vol. I, p. 28)

One such patent is U.S. Patent No. 3,044,798 (Record, Vol. II, pp. E1-E6) granted July 17, 1962, for an invention in an idler arm which is an essential component of the steering system for modern automobiles. This patent has seven claims. After Petitioner's company had placed his invented idler arm on the market, it was examined by the design engineers of Respondent and found to overcome the problems of previous idler arms which had plagued the industry. Respondent then placed on the market its version of Petitioner's invention. (Record, Vol. I, pp. 61-62, 66-67)

Action for infringement of the patent was instituted in the U.S. District Court for the Eastern District of Missouri, for the Eastern Division, and jurisdiction was predicated on 28 U.S.C. 1338(a). The District Court recognized that at most only claims 1, 4 and 5 were in issue (Appendix A, p. 1a). On June 8, 1966, Judge Meredith handed down his opinion holding the Gerner patent invalid without reference to any of the claims thereof. The District Court did not enter findings of fact or conclusions of law.

Judge Meredith nowhere identified the statutory provision or provisions upon which he determined invalidity. While a number of the prior patents were briefly considered, no attempt was made to anlayze the scope and content of the prior art and then determine what differences were defined in the Gerner

patent claims. The only statements made by the District Court which contain a comparative note are, "Gerner is basically a slightly different arrangement of the art which is already patented or in the public domain" (Appendix A, p. 8a), "it is clear to anyone skilled or unskilled how little variation in fact exists between Gerner and the prior art" (Appendix A, p. 8a), and "the Gerner patent when considered with the prior art and particularly that not cited by the Patent Office is invalid because the combination of old elements is obvious to anyone with ordinary mechanical skill" (Appendix A, p. 9a). Comparison with any of the patent claims in suit was totally overlooked.

Furthermore, Judge Meredith omitted any articulation of what he considered to be the level of ordinary skill in the pertinent art of automotive parts design. The District Court rendered no decision on the question of infringement.

The judgment entered by the District Court stated, "U.S. Patent No. 3,044,798, owned by Plaintiff Gerner, is invalid." (Record, Vol. I, p. 151)

Appeal was taken to the Court of Appeals for the Eighth Circuit. On September 19, 1967, that Court affirmed the District Court "holding invalid" the Gerner patent (Appendix B, p. 19a). The only claim considered by the Appeal Court was claim 1.

The Court below presumably rested its decision on 35 U.S.C. 103 in view of its conclusion,

> We are convinced that the disclosures found in the prior art buttressed by the testimony of the [Respondent's] expert witness provided a proper factual basis for the trial Court's determination

> of obviousness of the claimed invention under 35 U.S.C. § 103. (Appendix B, p. 19a)

However, the Court of Appeals also failed to make any comparison between the prior art references and even claim 1 of the Gerner patent in order to determine the differences which exist. The Court below gave only passing consideration to the critical difference urged by the Petitioner,

> It is argued that the three-section wedge means of Gerner is not disclosed in the prior art but the difference appears to be in configuration only because the prior art discloses upper and lower wedge means, which according to the witnesses perform the same function. (Appendix A, p. 19a)

However, the Appeal Court neglected to identify what witnesses and what testimony it was relying upon. In fact, the testimony was to the reverse because from an engineering standpoint the elements do not perform the same function. (Record, Vol. I, pp. 125-126)

The judgment of the Appeal Court affirmed the judgment of the District Court holding the Gerner patent invalid. Petition for rehearing was denied on November 6, 1967.

REASONS FOR GRANTING THE WRIT

The decision below should be reviewed because it erroneously holds the Gerner patent invalid where at most only a limited number of claims thereof were put in issue. The decision is in clear violation of federal statute, 35 U.S.C. 253, and in conflict with the decision of the Court of Appeals of the Third Circuit in *Chemical Construction Corp. v. Jones & Laughlin Steel Corp.*, 311 F.2d 367 (3rd Cir. 1962). Furthermore,

the decision has decided a federal question (the validity of the Gerner patent) without following the tenets established by the controlling authority of this Court in *Graham v. John Deere Co.*, 383 U.S. 1. In either event, this Court should grant review.

1. The Gerner patent includes seven claims. The District Court pointed out in its opinion that the instant action was for infringement of Gerner patent claims 1, 4 and 5 (Appendix A, p. 1a). Claims 2, 3, 6 and 7 were clearly not placed in issue in this case.

Section 253 (Title 35, U.S.C.) unequivocally specifies in the first sentence that where one claim of a patent is invalid, this does not render the remaining claims invalid. Section 288 (Title 35, U.S.C.) provides that a patentee may maintain suit for infringement of a valid patent claim even though the patent may contain or have contained (in the event of an earlier disclaimer) an invalid claim. These statutory provisions were enacted to remedy hardship developed by the common law which wholly voided a patent containing an invalid claim.

This Court had occasion to consider these provisions in *Ensten v. Simon Ascher Co.*, 282 U.S. 445. While the holding is directed to the diligence requirement in the then-existing predecessors of § 253 and § 288, it is clear from the opinion that a patent cannot be declared invalid based on an adjudication of only certain claims.

The Third Circuit Court of Appeals in *Chemical Construction Corp v. Jones & Laughlin Steel Corp.*, supra, specifically refused to adjudge claims of the patent in suit which had not been put in issue. The only claims of the Johnstone et al patent in issue at

the trial were 5, 6, 8 and 9 which were found by the trial court to be invalid. The appellate court affirmed as to these claims, but it specifically rebuked the attack on the remaining claims of the patent. The court pointed out that "any determination as to validity would have been error", because it "would have violated the rights reserved to the [patentee] by the disclaimer statutes" (at 311 F.2d 374).

Hence, the decision by the Court below is in violation of 35 U.S.C. 253, in seeming contravention of this Court's opinion in *Ensten v. Simon Ascher Co.,* supra, and in conflict with the decision of the Third Circuit in *Chemical Construction Corp.* v. *Jones & Laughlin Steel Corp.,* supra.

2. The District Court omitted any identification in its opinion (Appendix A) of the statutory provision or provisions underlying its conclusion that the Gerner patent is invalid. Assuming that the District Court was proceeding under 35 U.S.C. 103, and this appears to be the predicate for the conclusion reached by the Appeal Court below (Appendix B, p. 19a), both the District Court and the Court of Appeals failed to inquire into the basic considerations outlined by this Court in *Graham v. John Deere Co.* (at 383 U.S. 17) for determining the condition of patentability under § 103. In particular, neither Court presented a comparison of the prior art with the limitations defined in any claim of the Gerner patent, nor were any differences considered in light of what the Court deemed the expected skill in the art.

We believe that when a court decides a question of federal rights in conflict with the prior decision of the federal agency empowered by Congressional act

to determine and grant such rights, it is encumbent upon the court to clearly explain the rationale behind its reversal in precisely the manner prescribed for inquiry by this Court. In considering a question of patentability under 35 U.S.C. 103, this Court has cogently spelled out the three basic inquiries,

> [1] the scope and content of the prior art are to be determined;
>
> [2] differences between the prior art and the claims at issue are to be ascertained; and
>
> [3] the level of ordinary skill in the pertinent art resolved. (*Graham* v. *John Deere Co.*, 383 U.S. 1, 17)

Where a court reverses the decision of the Patent Office on patentability under § 103, it should be required to explain its application of the subject matter to these three basic inquiries. If this requirement was not made in *Graham*, its importance to the patent law necessitates its proclamation as soon as possible.

In any event, both the District Court and the Appeal Court failed to articulate their investigation of the Gerner invention as defined in the claims in terms consonant with the inquiries specified by this Court in *Graham*. The requirement of such articulation will lead to a more cogent and understandable statement from the lower courts and necessarily result in fairer decisions in patent litigation.

Further in this regard, it is pointed out that in the eleven decisions of the Eight Circuit Court of Appeals reported in the United States Patent Quarterly since this Court's decision in *Graham*, the Eighth Circuit has reversed the finding of the Patent Office in all

eleven cases and held each and every patent invalid on the basis of § 103.[1] In comparison, in the twenty-six reported decisions of the Court of Appeals for the Seventh Circuit, the Seventh Circuit has held claims in at least 45 percent of the cases valid.[2]

While these statistics in and of themselves are not relevant to the merits of the Gerner patent, they do reveal the great disparity between two contiguous Courts of Appeal on the application of the standards for patentability under § 103 and an important reason for review in this case.

3. The questions presented to this Court are of recurring significance in patent litigation. The disparity in the application of the test of patentability under § 103 by the Court of Appeals makes necessary a reiteration and reinforcement of the basic inquiries set forth in *Graham*. The conflict of the decision below with federal statute and decisions of this Court and other Courts of Appeal and the importance of the test of patentability under 35 U.S.C. 103 make this case peculiarly appropriate for the exercise of this Court's discretionary jurisdiction.

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[1] The reported decisions of the Eighth Circuit are tabulated in Appendix C, pp. 20a-21a.

[2] The reported decisions of the Seventh Circuit are tabulated in Appendix D, pp. 22a-24a.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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APPENDIX A

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION

No. 64 C 432 (2)

THEODORE C. GERNER, Plaintiff,

vs.

MOOG INDUSTRIES, INC., Defendant.

Memorandum

This matter was tried to the Court without a jury and the Court has been duly advised by testimony, documentary evidence and briefs of all the parties and makes the following findings of fact and conclusions of law:

Plaintiff, Theodore C. Gerner, is a citizen of The United States and a resident of the State of Oklahoma and defendant, Moog Industries, Inc., is a Missouri corporation having its principal place of business at St. Louis, Missouri. Plaintiff Theodore C. Gerner is the owner of United States Patent 3,044,798, granted July 17, 1962, the patent involved in this suit. This is an action for infringement of the Gerner patent, particularly claims 1, 4 and 5. The Court has jurisdiction over the parties and of this cause of action, under 28 U.S.C. 1338(a) and 1400(b). The plaintiff relies on claim 1 as being exemplary of the infringement issue. The plaintiff through his company, National Machine Works, Inc., began selling idler arms manufactured in accordance with his patented invention during the year 1960.

Claim 1 of the Gerner patent is stated as follows:

> "A replacement assembly for idler arms of an automobile steering linkage comprising an idler arm having a pivotal connection at one end for journaling the same upon the chassis of an automobile and having a pivotal connection at its other end for engagement with a portion of a steering linkage, at least one of said pivotal connections including a female member having a bore therein and a male member received therein, said male member including diametrically enlarged reversely varying surfaces, upper and lower wedge means each slidably received in and engaging the wall of the bore in said female member and having wedging surfaces complementary to and engaging those of the male member, resilient means yieldingly and continuously urging said wedge means into wedging contact with said male member and the female member whereby to automatically take up wear therebetween, said diametrically enlarged reversely varying surfaces being conical."

The Gerner invention is best illustrated by Figure 2 of the patent drawings (plaintiff's exhibit 1 and defendant's exhibit A), a copy of which is attached hereto, and plaintiff's exhibit 2, a prototype model. In Figure 2 of the patent drawings, the frame bracket end pivotal connection is at the right-hand end. The assembly of this pivotal connection is identical with that illustrated in the cross section on the left-hand end, except it is disposed in reverse position.

The purpose of the Gerner idler arm is to rid the automobile steering linkage of all play.

The Gerner idler arm has at the frame bracket end a female housing with a cylindrical bore therein. The bore receives three lower wedge elements which are slid to the bottom of the bore. The male pin with upper and lower reversely varying conical surfaces is positioned in the bore

whereby the lower conical surface contacts the interior surface of each lower wedge element. Three upper wedge elements are then slid into the bore with their interior surfaces each contacting the upper conical surface of the male pin. The exterior surface of each upper and lower wedge element is cylindrical and makes such contact with the bore as to inhibit relative rotational movement. The interior surface of each upper and lower wedge element is conical and contacts the corresponding upper and lower surface of the male pin to permit relative rotation therebetween. Accordingly, the bearing surfaces for the pivotal connection are those surfaces on the interior of the wedge elements and on the male pin which are in contact.

The three upper and the three lower wedge elements represent axially spaced supports which at any time define a stationary rotational axis for the idler arm at the frame bracket end pivotal connection. A spring in combination with a cover maintains the contact of the male pin surfaces with the interior surfaces of all the wedge elements.

The spring in urging the three upper wedge elements onto the upper bearing surface of the male pin forces the three upper and three lower wedge elements to expand due to the conical shape of the upper and lower bearing surfaces of the male pin. The force expanding the upper and lower wedge elements produces a wedging contact between their exterior cylindrical surface and the bore surface. The downward force on the three upper wedge elements also urges the male pin into its lowermost position with its lower bearing surface against the interior conical surface of each lower wedge element which in turn are each in contact with the bore. Thus, any machining imprecision existing between the bore, the wedge elements and the male pin is automatically compensated for and any looseness which might otherwise exist is eliminated.

As wear takes place during normal operation between the two conical surfaces of the male pin and the interior

surfaces of the six wedge elements, the spring forces the three upper wedge elements further into the bore against the upper conical surface of the male pin and forces the male pin down on the three lower wedge elements, thereby taking up any wear therebetween and at the time causing all the wedge elements to expand further (if necessary) against the surface of the bore. Accordingly, all wear occurring in the pivotal connection is automatically taken up by adjustment of the three upper and three lower wedge elements and the male pin.

In the event the pivotal connection is subject to a shock whereby the upper or lower conical surface of the male pin is temporarily dislodged from contact with any of the three upper wedge elements or three lower wedge elements, the force of the spring will automatically reset contact of the components in the same manner as described above with respect to assembly of the pivotal connection.

Defendant is presently manufacturing a series of idler arm structures illustrated by plaintiff's exhibit 8a through 8r, which are drawings of the structures, plaintiff's exhibits 4, 5 and 6, physical models, and defendant's exhibit I, an illustrative model of the Moog structure. Defandant's exhibit D, a drawing of the structure, is attached hereto.

Defendant had been manufacturing and selling a ball bearing idler arm kit for many years prior to the Gerner patent, which eliminated looseness. The idler arms of Moog, which plaintiff contends infringes his patent, were designed in 1963. The engineers of defendant Moog had examined the Gerner structures, as well as those of other competitors, and the prior art, before designing the questioned structures.

In comparing the Gerner idler arm and the Moog idler arm there are certain differences apparent.

The three lower and three upper wedge elements of Gerner are loosely slidably received in the bore of the female member. These wedge elements engage the reversely

tapered surfaces of the male pin and the spring on the upper wedge elements permit a yielding and continuously urging of the wedge elements into wedging contact with the pin.

In the Moog device the lower element is a solid ring element which is forced by pressure into the female housing and remains fixed at that point. It is not three separate wedge elements. It cannot slide up and down.

It is to be noted here that the language of claim 1 of the Gerner patent is as follows:

> ". . . upper and lower wedge means each slidably received in and engaging the wall of the bore in said female member and having wedging surfaces complementary to and engaging those of the male member, . . ."

The three upper wedge elements of Moog and the bottom ring have only point contact with the male pin. In Gerner the surfaces of the wedge elements have complementary conical surfaces that contact the male pin.

The spring in Moog has no effect on the bottom element which is fixed, but only urges point contact of the upper wedges with the male pin. The spring in Gerner urges continuous wedging of both the top and bottom wedge elements with the male pin.

Even if this Court were to find the Gerner patent valid, the difference between Moog and Gerner makes it doubtful if there is any infringement. However, it is not necessary to decide this question in view of the fact that after reviewing the prior art this Court is of the opinion that the Gerner patent does not stand the tests necessary to make it a valid patent.

The Constitution, Art. I, § 8, cl. 8, authorizes Congress "To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right

to their . . . Discoveries." The Supreme Court in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), pointed out

> "The clause is both a grant of power and a limitation . . . Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available."

The Court said further in quoting *Hotchkiss* v. *Greenwood*, 11 How. 248 (S.Ct. 1851), l.c. 267:

> "[U]nless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor."

The Court went on to emphasize that Congress in § 103 of the 1952 Patent Act has made the language of Hotchkiss a statutory condition by requiring the invention to be one that was not obvious to a person skilled in the arts, when comparing the invention to the prior arts.

In a recent case, *Kell-Dot Industries, Inc.*, v. *Graves*, (May 18, 1966), the Eighth Circuit in reversing the district court and finding a patent invalid, said at page 11 of the slip opinion:

> "We are convinced here that anyone skilled in the art with patent office references before him could have, without the exercise of any inventive faculty, combined old elements known to the art and made plaintiff's machine. Assuming that the patent in suit was an improvement over the prior art, it still does not rise to the level of patentability."

The facts in the Gerner patent fall within the language of the Eighth Circuit and the Supreme Court in that the Gerner patent is invalid because it is an obvious change to anyone skilled in the arts and does not rise to the standard necessary to make it patentable.

The file jacket of the Patent Office shows that all claims were initially rejected. After minor changes seven of the claims were allowed. Reference was made by the Patent Office to the following prior art: 1,261,856, Rule; 1,871,861, Rossman; 1,985,728, Ingersoll; 2,037,786, Hufferd; 2,048,803, Marles; 2,544,582, Booth; 2,745,688, Farrington; 2,853,327, Traugott; and foreign patent 513,858, Italy (Sell).

The defendant relies on the referenced prior art and additional patents: Swiss, 111,900; Greenwalt, 2,685,451; Cain, 2,769,651; Prichard, 2,826,466; and Herbenar, 2,937,033 and 2,944,829.

The Ingersoll patent granted in 1934 is a ball and socket joint used in cross tie rods connecting the steering arms of the front axle in motor vehicles. This patent drawing shows almost the identical principal [sic] applied in Gerner. Figures 1, 2 and 3 of defendant's exhibit B, a copy of which is attached hereto, show socket pieces with reversely tapered surfaces, slidably received into the base of a housing, an upper and lower set of rings having tapered surfaces engaging the tapered surfaces of said socket pieces, and a spring to force the rings in continuous contact with the tapered surfaces of the socket pieces. The patent additionally has a ball shaped stud within the tapered socket pieces. The principal [sic] of Ingersoll is not greatly different from Gerner.

The Swiss patent granted in 1925, while being used as a connecting joint for shock absorbing mechanisms shows a similar device to Gerner's. Defendant's exhibit F (figure 16), a copy of which is attached hereto, shows the reversely tapered pin fitting into a pivot assembly with two wedging

rings fitting against the reversely tapered pin. The rings fit into a housing and in this instance there is a leaf spring (defendant's exhibit F, figure 19), which may be used to maintain the relative position of the bearing surfaces.

The Hufferd patent granted in 1931 is an improved form of adjustable ball joint connection for the tie rod and drag links used in the steering mechanism of automobile vehicles. The patent has the ball stud surrounded by positioned tapered sleeves with a spring to take up wear and not affect the alignment of the tie rod. The spring forces the wedgelike segments together.

Without going into all the other referenced patents, but considering briefly Cain, granted in 1956, for an adjustable idler arm support and Herbenar, granted in 1960, for a vehicle idler arm assembly, we can see that Gerner is basically a slightly different arrangement of the art which is already patented or in the public domain.

When the patent drawings of Gerner, the Swiss patent and the Ingersoll patent are placed side by side, and the pertinent characteristics are set out in identical colors, it is clear to anyone skilled or unskilled how little variation in fact exists between Gerner and the prior art. Therefore, copies of these drawings together with a cross section of the Moog device are attached to and made a part of this opinion for the purpose of clarity.

The plaintiff tries to get some comfort from the case of *United States* v. *Adams,* 383 U.S. 39 (1966), but the facts in that case are very different. In that case the Court found the device passed the separate tests of novelty, nonobviousness and utility. The battery was the first water-activated battery ever invented. The Patent Office cited not a single reference when it was granted. After the patent was furnished to the Army and Navy in 1941 and tests were made and the battery was studied for a year, the National Bureau of Standards experts had doubts that the battery

would work. So, certainly it was not obvious to one skilled in the field.

The Patent Office in Gerner did not consider or reference Cain or the Swiss patent 111900. Had these been considered, they may have reached a different result.

The Court agrees with the plaintiff that the grant of a patent carries with it a presumption of validity. However, this is a rebuttable presumption, *Steffan* v. *Weber Heating,* 237 F.2d 601 (8 Cir. 1956), and validity of an invention is ultimately a question that the courts must decide, *Continental Farm Equip.* v. *Love,* 199 F.2d 202 (8 Cir. 1952).

The Gerner patent when considered with the prior art and particularly that not cited by the Patent Office is invalid because the combination of old elements is obvious to anyone with ordinary mechanical skill.

Accordingly, a judgment will be entered for the defendant and against the plaintiff. Defendant's counsel is directed to prepare the judgment in accordance with this memorandum and submit the same to the Court and a copy to counsel for plaintiff within 10 days.

Dated this 8th day of June, 1966.

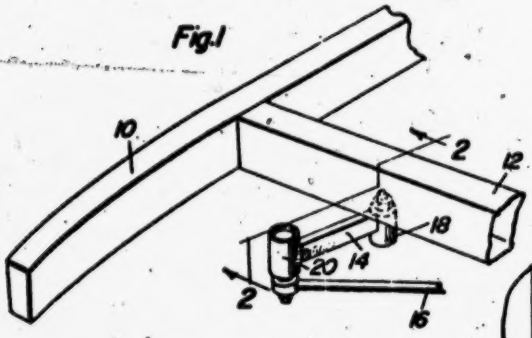
/s/ JAMES H. MEREDITH
United States District Judge

July 17, 1962 T. C. GERNER 3,044,798

REPLACEMENT UNIT FOR IDLER ARM BRACKET

Filed March 6, 1959 2 Sheets-Sheet 1

Fig.1



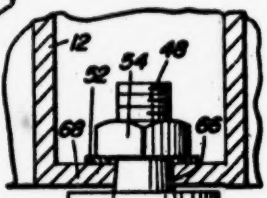
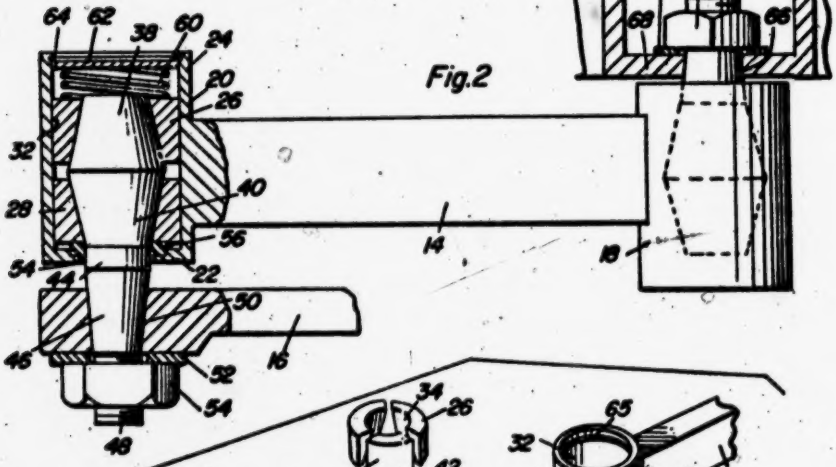


Fig.2



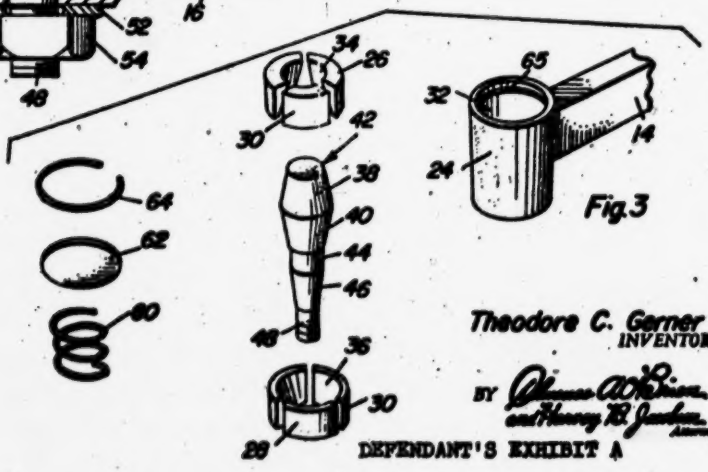


Fig.3

Theodore C. Gerner
INVENTOR.

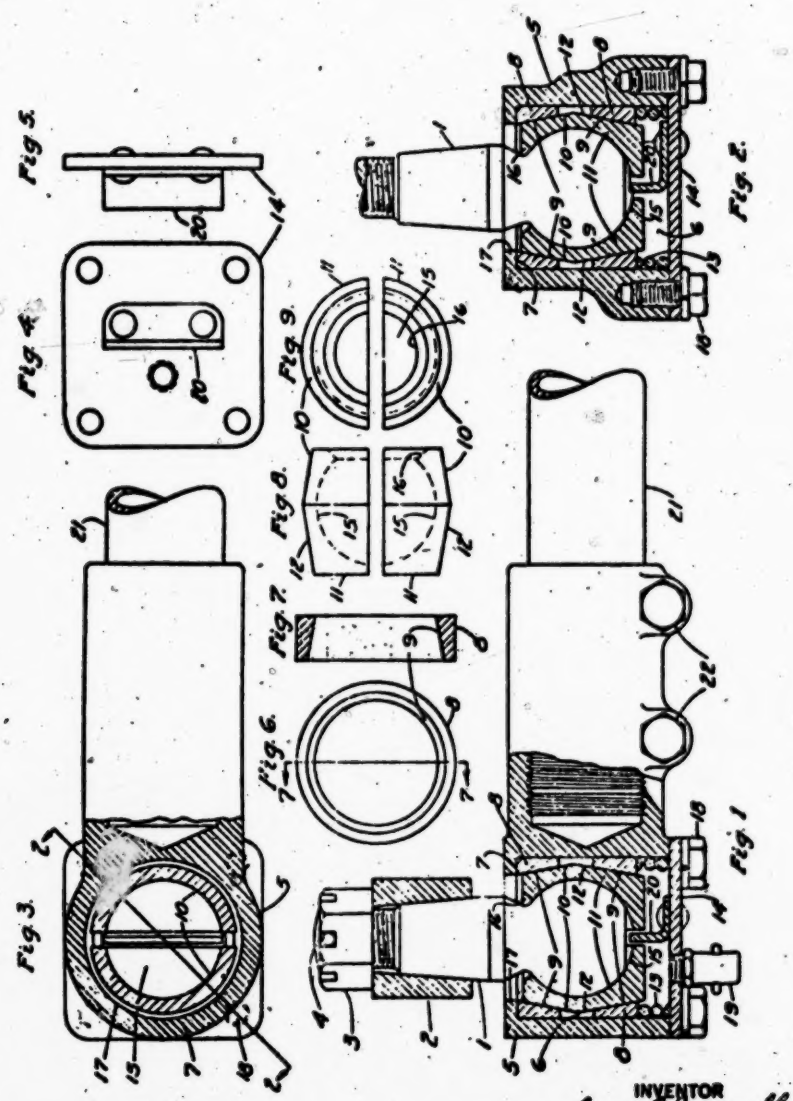
BY [signature]
and Harvey R. Jackson
Attorneys

DEFENDANT'S EXHIBIT A

Dec. 25, 1934. G. B. INGERSOLL 1,985,728

BALL AND SOCKET JOINT

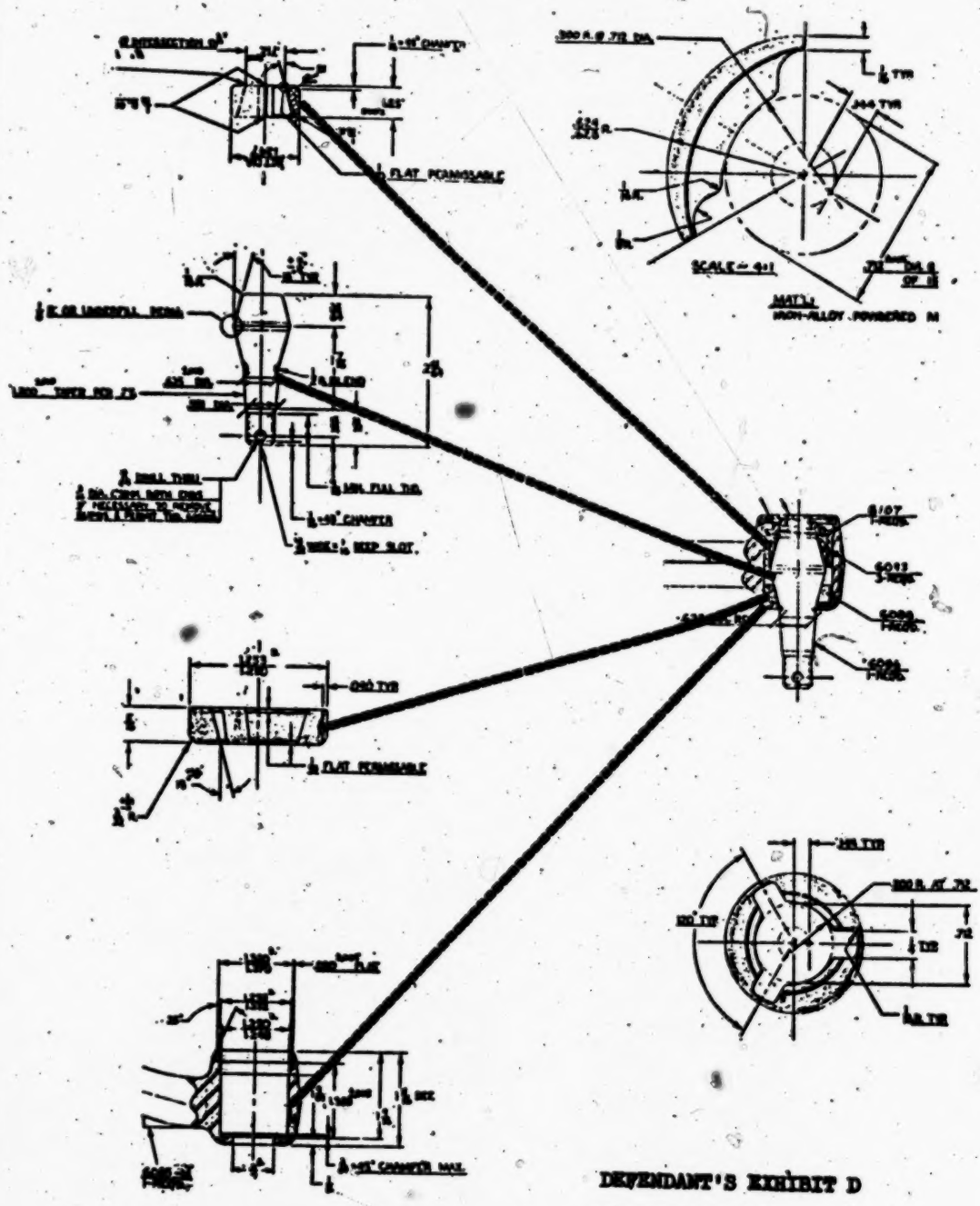
Original Filed Nov. 15, 1927



INVENTOR

George B. Ingersoll

DEFENDANT'S EXHIBIT B



DEFENDANT'S EXHIBIT D

MOOG IDLER ARM

Fig.10

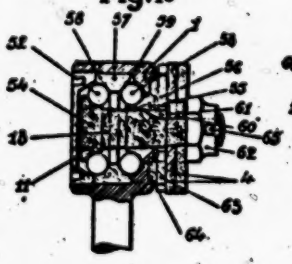


Fig.11

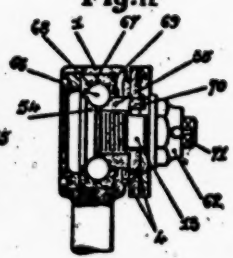


Fig.12

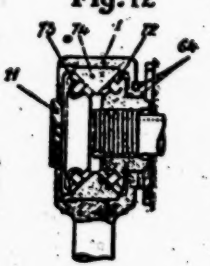


Fig.13

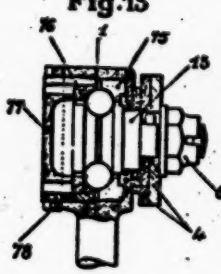
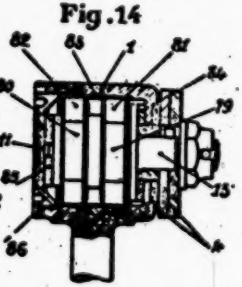


Fig.14



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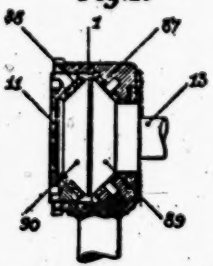


Fig.16

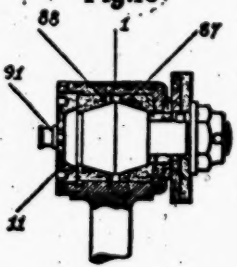


Fig.17

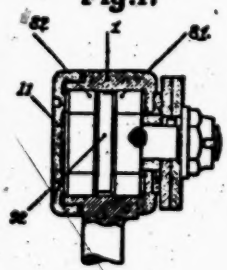


Fig.18

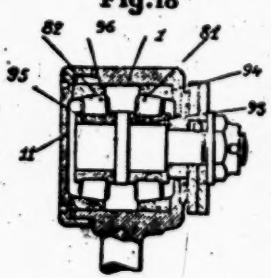


Fig.19

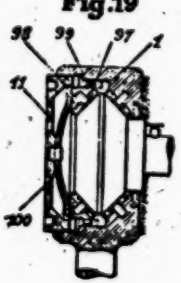


Fig.20

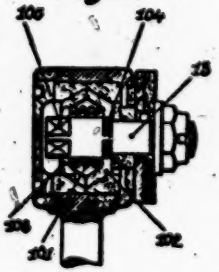


Fig.21

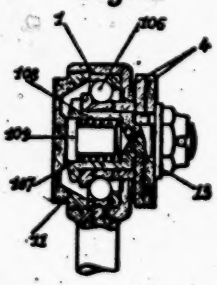


Fig.22

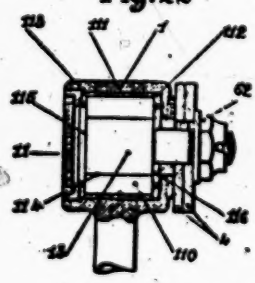


Fig.23

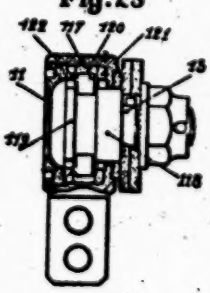
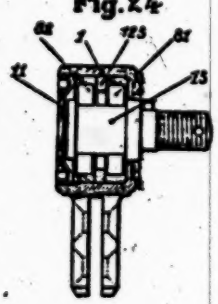


Fig.24



SWISS PATENT 111900, GRANTED 1925, DEFENDANT'S EXHIBIT 7

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

No. 18,525

THEODORE C. GERNER, Appellant,

v.

MOOG INDUSTRIES, INC., Appellee.

Appeal from the United States District Court
for the Eastern District of Missouri.

[September 19, 1967.]

Before BLACKMUN, MEHAFFY and GIBSON, Circuit Judges.

MEHAFFY, Circuit Judge.

The sole issue for determination upon this appeal is the validity of United States Patent No. 3,044,798 which issued to Theodore C. Gerner on July 17, 1962. Gerner, a citizen and resident of Oklahoma, brought suit against Moog Industries, Inc., a Missouri corporation, alleging infringement of the patent. Moog denied infringement and additionally set up as a defense the invalidity of the patent.

The District Court in an opinion published at 254 F. Supp. 969 (E.D. Mo. 1966) held the patent invalid as

being a combination of old elements obvious to anyone with ordinary mechanical skill. We affirm.

The Patent in Issue

The Gerner patent is a mechanical structure relating to the steering mechanism of an automobile. It is designed as a replacement unit for what is called an idler arm bracket, its object being to eliminate looseness or end play in the steering linkage. An idler arm is part of the automobile parallelogram steering linkage. It has a frame bucket end attaching to the front portion of the chassis opposite what is called the "pitman" arm on the steering column. The other end of the idler arm supports the steering linkage. Originally, the Patent Office rejected all claims but subsequently, upon amendment, the patent was issued. Claim 1 is the broadest in the patent and the elements and functions of the device are embodied therein:

> "1. A replacement assembly for idler arms of an automobile steering linkage comprising an idler arm having a pivotal connection at one end for journaling the same upon the chasis of an automobile and having a pivotal connection at its other end for engagement with a portion of a steering linkage, at least one of said pivotal connections including a female member having a bore therein and a male member received therein, said male member including diametrically enlarged reversely varying surfaces, upper and lower wedge means each slidably received in and engaging the wall of the bore in said female member and having wedging surfaces complementary to and engaging those of the male member, resilient means yieldingly and continuously urging said wedge means into wedging contact with said male member and the female member whereby to automatically take up wear therebetween, said diametrically enlarged reversely varying surfaces being conical."

Specifically, the Gerner device embodies a female housing with a cylindrical bore which receives three lower wedge or bearing elements slidably placed therein. The male member has upper and lower reversible varying conical surfaces and is positioned in the bore so that the lower conical surfaces contact the interior surface of the lower bearing. Three upper wedge or bearing elements are likewise slidably introduced into the bore with interior surfaces contacting the upper conical surface of the male pin. The exterior of each upper and lower bearing is cylindrical and designed to make contact with the bore surface so as to inhibit rotational movement. The interior surface of each bearing element is conical in design to contact the corresponding surface of the male pin to permit relative rotation between. A spring maintains contact between the male pin surfaces and the surfaces of the bearing elements and urges the three upper bearing elements into a wedging contact with the upper bearing surface of the male pin. This force produces a wedging contact urging the male pin into its lower most position and contacts against the interior surface of each lower bearing element. The effect of this is to automatically compensate for any tolerance that might exist between the bore, the wedge or bearing elements and the male pin in order to eliminate any looseness that might exist.

Gerner does not claim that his is the first idler arm but only that it meets the statutory requirement for patentability. As a matter of fact, other manufacturers, including Moog, were producing idler arms before the Gerner patent but their ball bearing structures did not lend themselves as well to one particular automobile, the Chevrolet.

The Prior Art

Obviously, this is a crowded field as the references cited in the Patent Office file are: 1,261,856 Rule; 1,871,861 Rossman; 1,985,728 Ingersoll; 2,037,786 Hufferd; 2,048,803

Marles; 2,544,582 Booth; 2,745,688 Farrington et al; 2,853,327 Traugott; and 513858 Italy.

In addition to the prior art referenced by the Patent Office, Moog introduced at trial 111,900 Swiss; 2,769,651 Cain; 2,685,451 Greenwalt; 2,826,466 Pritchard; 2,937,033 Herbenar; and 2,994,829 Herbenar.

Patent drawings from Gerner, Ingersoll and Swiss, as well as the accused device, are attached to the District Court's opinion and we adopt them by reference.

The Swiss patent, as does Gerner, includes a male and female member with oppositely formed conical surfaces on the male member and with both upper and lower wedges or bearings slidably received in the female member having surfaces engaging those of the male member. It also embodies spring means which continuously urge the wedge means into wedging contact with the male member.

Cain also embodies a male and female member with oppositely formed conical surfaces on the male member and with upper and lower wedge means with surfaces complementary to and engaging those of the male member. Cain does not embody a spring but is constructed so the wedge means can be threaded up to adjust for wear.

The Ingersoll patent contains a male and female member with upper and lower wedge means and the bore of the female member having surfaces complementary to and engaging those of the male member.

The trial court found that a consideration of the Cain and Herbenar patents revealed that Gerner is basically a slightly different arrangement of the art which is already patented or in the public domain. The court stated that when the patent drawings of Gerner, Swiss and Ingersoll are placed side by side and the patent characteristics set out in identical colors, it is clear even to the unskilled how little variation in fact exists between Gerner and the prior art. Noting that the Patent Office in Gerner did not con-

sider or reference the Cain or Swiss patents, the trial court observed that had these two patents been considered the action of the Patent Office might have been different.

Professor Fisher, an expert for Moog, testified that all of the structures called for in Gerner Claim 1 are found in the Ingersoll patent and also that the Swiss patent, structure for structure, absolutely responds to the Gerner patent.

Gerner argues stenuously that both the trial court and Moog's expert exercised hindsight in arriving at their conclusions, but we disagree. The trial court's opinion not only reflects an intimate knowledge of the structure and functions of the patented device but a scrupulous adherence to the teachings of the Supreme Court in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), and its companion cases. A number of our post-*Graham* patent opinions holding invalidity for obviousness under 35 U.S.C. § 103, as interpreted and taught by *Graham*, are cited in *L & A Products, Inc.* v. *Britt Tech Corp.*, 365 F.2d 83 (8th Cir. 1966). See also *Superior Concrete Accessories* v. *Richmond Screw Anchor Co.*, 369 F.2d 353 (8th Cir. 1966); *Imperial Stone Cutters, Inc.* v. *Schwartz*, 370 F.2d 425 (8th Cir. 1966). Further discussion here on the subject of nonpatentability for obviousness under § 103 as interpreted in *Graham, supra*, is unnecessary.

Gerner points out that the Ingersoll and Swiss patents relate to pivotal connections generally and not replacement idler arms. Prior art, however, includes earlier devices whether or not in related areas to the patented device. *Skee-Trainer, Inc.* v. *Garelick Mfg. Co.*, 361 F.2d 895, 898 (8th Cir. 1966). The Ingersoll patent referred to a socket joint on the end of a tie rod and the Swiss patent is for a shock absorber and not directly for an idler arm, yet both relate to automobile mechanisms. Moog's expert witness testified that if somebody wanted a joint that takes up wear, it would only be necessary to utilize the Swiss disclosure.

It is argued that the three-section wedge means of Gerner is not disclosed in the prior art but the difference appears to be in configuration only because the prior art discloses upper and lower wedge means, which according to the witnesses perform the same function. But even if the addition of a new element to an otherwise old combination may create a new combination, this factor in itself does not eliminate the requirement of 35 U.S.C. § 103 that such a new combination is unpatentable unless the invention as a whole was unobvious to one of ordinary skill in the art at the time it was made. *Cf. Application of Grout,* 377 F.2d 1019 (C.C.P.A. 1967).

We are convinced that the disclosures found in the prior art buttressed by the testimony of the expert witness provided a proper factual basis for the trial court's determination of obviousness of the claimed invention under 35 U.S.C. § 103. To paraphrase the language of the Supreme Court in *Hotchkiss* v. *Greenwood,* 11 How. 248, quoted in *Graham, supra,* 383 U.S. at 11—if there is improvement in the Gerner patent it is the work of a skilled mechanic and not that of an inventor.

The secondary considerations—commercial success, failure of others, and long-standing need—do not, in our opinion, approach in substance those in *Graham, supra,* which failed to impress the Supreme Court in its consideration of the companion *Calmar* case, 383 U.S. 1, 35, 36, so as to tilt the balance to patent validity where the device fails to meet the nonobvious standard of § 103. *Cf. Kell-Dot Industries, Inc.* v. *Graves,* 361 F.2d 25, 30, 31 (8th Cir. 1966).

The judgment of the District Court holding invalid United States Patent No. 3,044,798 issued to Theodore C. Gerner, July 17, 1962, is affirmed.

A true copy.
Attest:

Clerk, U.S. Court of Appeals, Eighth Circuit.

APPENDIX C

Eighth Circuit Post-Graham Decisions

	Invalid Valid*	Reversed Affirmed
1. *Kell-Dot Industries, Inc.* v. *Graves,* 361 F.2d 25, 149 USPQ 717 (8th Cir. 1966)	Invalid	Reversed
2. *American Infra-Red Radiant Co.* v. *Lambert Industries, Inc.,* 360 F.2d 977, 149 USPQ 722 (8th Cir. 1966)	Invalid	Reversed
3. *Skee-Trainer, Inc.* v. *Garelick Mfg. Co.,* 361 F.2d 895, 150 USPQ 7 (8th Cir. 1966)	Invalid	Affirmed
4. *Piel Manufacturing Company* v. *George A. Rolfes Co.,* 363 F.2d 57, 150 USPQ 330 (8th Cir. 1966)	Invalid	Affirmed
5. *Automated Building Components* v. *Hydro-Air Engineering,* 362 F.2d 989, 150 USPQ 421 (8th Cir. 1966)	Invalid	Affirmed
6. *Superior Concrete Accessories* v. *Richmond Screw Anchor Co.,* 369 F.2d 353, 151 USPQ 677 (8th Cir. 1966)	Invalid	Affirmed
7. *Imperial Stone Cutters, Inc.* v. *Schwartz,* 370 F.2d 425, 152 USPQ 91 (8th Cir. 1966)	Invalid	Affirmed
8. *L & A Products, Inc.* v. *Britt Tech Corporation,* 365 F.2d 83, 150 USPQ 770 (8th Cir. 1966)	Invalid	Reversed

* The patent validity determination is indicated valid where the Court held at least one claim of a patent in suit valid.

	Invalid	Reversed
	Valid*	Affirmed
9. *Greening Nursery Co.* v. *J & R Tool & Mfg. Co.*, 376 F.2d 738, 153 USPQ 660 (8th Cir. 1967)	Invalid	Affirmed
10. *General Mills, Inc.* v. *Pillsbury Co.*, 378 F.2d 666, 154 USPQ 207 (8th Cir. 1967)	Invalid	Reversed
11. *Gerner* v. *Moog Industries, Inc.*, —— F.2d ——, 155 USPQ 232 (8th Cir. 1967)	Invalid	Affirmed

* The patent validity determination is indicated valid where the Court held at least one claim of a patent in suit valid.

APPENDIX D

Seventh Circuit Post-Graham Decisions

	Invalid Valid*	Reversed Affirmed
1. *Toro Manufacturing Corporation* v. *Jacobsen Manufacturing Company,* 357 F.2d 901, 148 USPQ 628 (7th Cir. 1966)	Invalid	Reversed
2. *Eugene A. Wahl and Vibra Screw Feeders Inc.* v. *Carrier Manufacturing Co., Inc.,* 358 F.2d 1, 148 USPQ 698 (7th Cir. 1966)	Valid	Affirmed
3. *King-Seeley Thermos Co.* v. *Tastee Freez Industries, Inc.,* 357 F.2d 875, 149 USPQ 4 (7th Cir. 1966)	Valid	Affirmed
4. *Corn Products Company* v. *Standard Brands, Inc.,* 359 F.2d 739, 149 USPQ 316 (7th Cir. 1966)	Invalid	Affirmed
5. *Benjamin A. Skirow and Nathan Skirow, d/b/a Skirow Brothers, a partnership,* v. *Roberts Colonial House, Inc.,* 361 F.2d 388, 149 USPQ 882 (7th Cir. 1966)	Invalid	Affirmed
6. *Continental Can Company, Inc.* v. *Anchor Hocking Glass Corporation,* 362 F.2d 123, 150 USPQ 1 (7th Cir. 1966)	Valid	Affirmed
7. *Automated Building Components, Inc.* v. *Structomatic, Inc.,* 362 F.2d 529, 150 USPQ 159 (7th Cir. 1966)	Invalid	Affirmed

* The patent validity determination is indicated valid where the Court held at least one claim of a patent in suit valid.

	Invalid Valid*	Reversed Affirmed
8. *Rex Chainbelt, Inc.* v. *General Kinematics Corporation,* 363 F.2d 336, 150 USPQ 319 (7th Cir. 1966)	Valid	Affirmed
9. *Zegers* v. *Zegers, Inc.,* 365 F.2d 156, 150 USPQ 409 (7th Cir. 1966)	Valid	Affirmed
10. *Wen Products Inc.* v. *Portable Electric Tools, Inc.,* 367 F.2d 764, 151 USPQ 366 (7th Cir. 1966)	Valid	Affirmed
11. *Walt Disney Productions* v. *Fred A. Niles Com. Ctr., Inc.,* 369 F.2d 230, 151 USPQ 528 (7th Cir. 1966)	Valid	Reversed
12. *T. P. Laboratories, Inc.* v. *Huge,* 371 F.2d 231, 151 USPQ 605 (7th Cir. 1966)	Invalid	Affirmed
13. *Strzalkowski* v. *Beltone Electronics Corporation,* 371 F.2d 237, 151 USPQ 675 (7th Cir. 1966)	Invalid	Affirmed
14. *Williams* v. *V. R. Myers Pump and Supply, Inc.,* 371 F.2d 192, 152 USPQ 1 (7th Cir. 1966)	Valid	Affirmed
15. *La Maur, Inc.* v. *DeMert & Dougherty, Inc.,*——F.2d——, 152 USPQ 163 (7th Cir. 1965)	Invalid	Affirmed
16. *Armstrong* v. *Motorola, Inc.,* 374 F.2d 764, 152 USPQ 535 (7th Cir. 1967)	Valid	Affirmed
17. *Novo Industrial Corporation* v. *Standard Screw Company,* 374 F.2d 824, 152 USPQ 543 (7th Cir. 1967)	Invalid	Affirmed

* The patent validity determination is indicated valid where the Court held at least one claim of a patent in suit valid.

	Invalid Valid*	Reversed Affirmed
18. *Bishman Manufacturing Co.* v. *Stewart-Warner Corp.*, —— F.2d ——, 153 USPQ 496 (7th Cir. 1966)	Valid	Affirmed
19. *Groen* v. *General Foods Corp.*, —— F.2d ——, 152 USPQ 210 (7th Cir. 1966)	Invalid	Affirmed
20. *Pambello* v. *Hamilton Cosco, Inc.*, 377 F.2d 445, 153 USPQ 658 (7th Cir. 1967)	Invalid	Reversed
21. *Sanford Research Co.* v. *Eberhard Faber Pen & Pencil Co.*, 379 F.2d 512, 154 USPQ 199 (7th Cir. 1967)	Invalid	Affirmed
22. *Gass* v. *Montgomery Ward & Co.*, —— F.2d ——, 155 USPQ 199 (7th Cir. 1967)	Invalid	Reversed
23. *American Photocopy Equipment Co.* v. *Rovico, Inc.*, —— F.2d ——, 155 USPQ 119 (7th Cir. 1967)	Valid	Affirmed
24. *Unarco Industries, Inc.* v. *Evans Products Co.*, —— F.2d ——, 155 USPQ 230 (7th Cir. 1967)	Invalid	Affirmed
25. *Leach* v. *Badger Northland, Inc.*, —— F.2d ——, 155 USPQ 365 (7th Cir. 1967)	Invalid	Affirmed
26. *Technicon Instruments Corp.* v. *Coleman Instruments*, —— F.2d ——, 155 USPQ 369 (7th Cir. 1967)	Valid	Affirmed

* The patent validity determination is indicated valid where the Court held at least one claim of a patent in suit valid.

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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1967.

No. 920.

THEODORE C. GERNER,
Petitioner,

vs.

MOOG INDUSTRIES, INC.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

JOSEPH J. GRAVELY,
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Authorities Cited and Relied Upon.

Congress of Industrial Organizations, et al. v. McAdory, County Solicitor, et al., 325 U. S. 472, 477, 65 S. Ct. 1395, 1398	8
Kawneer Co. v. Pittsburg Plate Glass Co., 103 F. Supp. 671, 676, 93 U. S. P. Q. 3, 7	7
Lockner Co., Inc. v. Quehl Sign Co., 145 F. 2d 932, 934 (6 CA-1944)	7
Oswego Falls Corporation v. American Seal-Kap Corporation, 65 F. Supp. 338, 69 U. S. P. Q. 155	8
Sinclair & Carroll Co., Inc. v. Interchemical Corporation, 325 U. S. 327, 65 S. Ct. 1143	12
Sterling Aluminum Products, Inc. v. Bohn Aluminum & Brass Corp., 298 F. 2d 538, 132 U. S. P. Q. 365 (6 CA-1962)	7
Walters, et al. v. City of St. Louis, et al., 347 U. S. 231, 233 (2), 74 S. Ct. 505, 507	8

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RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

INTRODUCTION.

This cause of action is a typical case of patent infringement which must depend for decision entirely upon its own facts. Two courts below have unanimously resolved the disputed questions of facts and the applicable law in favor of the Respondent, and under this state of the case the Petition for Writ of Certiorari should be denied.

The questions presented as stated in the Petition are:

I. Whether a patent can be adjudicated invalid where only certain of the claims thereof are put in issue; and

II. Whether, in considering the conditions for patentability under 35 U. S. C. 103, this Court's opinion in Graham v. John Deere Co., 383 U. S. 1, requires a specific determination of (a) the scope and content of the prior

art; (b) the difference between such prior art and the patent claims in suit; and (c) the level of ordinary skill in the pertinent art.

The questions proposed by Petitioner are not those which this Court should consider for the following reasons:

1. The Petitioner does not set forth any special and important reasons for granting Certiorari as required by Rule 19 of the Supreme Court of the United States.

2. While Petitioner's first question is premised on the allegation of a conflict between two Circuit Courts of Appeals on the same legal proposition, it will appear presently that nothing could be farther from the fact because the legal proposition placed before the respective Circuit Courts of Appeal are entirely different.

3. If the Petitioner desired the District Court's opinion to be more analytical and to make more detailed comparisons with prior art, and particular mention of claims 2, 3, 6 and 7, then he should have made a motion to that effect in the District Court, and should also have included such questions and issues in his motion for rehearing filed in the Court of Appeals. Under the decisions of this Court, questions and issues not raised in the Court below cannot be for the first time considered by this Court.

4. It will appear from the decisions of both Courts below that each was fully cognizant of the conditions for patentability under 35 U. S. C. 103, and the opinions rendered clearly reflect the court's awareness of the Graham v. John Deere decision of 383 U. S. 1.

SUMMARY OF FACTUAL BACKGROUND.

Respondent is in disagreement with Petitioner's statement of the case. Petitioner continues to argue the merits of the patent and criticizes the decision of the District Court. These are matters which the Court of Appeals has

considered and with which it agreed. Petitioner has failed to present an adequate background that is relevant and significant to the questions presented for review.

Respondent's view of pertinent and relevant background for the first question presented is this:

The action in the District Court for the Eastern District of Missouri, Eastern Division, was instituted December 1, 1964, by Petitioner filing its Complaint alleging, in paragraph 6, that "Defendant has infringed and still is infringing said Letters Patent No. 3,044,798 by making, selling, and/or using replacement units for idler arm bracket embodying the invention of said Letters Patent, and will continue to do so unless enjoined by this Court". Petitioner also in its Prayer for Relief asked "That a preliminary and final injunction issue against further infringement by Defendant and those controlled by Defendant of Plaintiff's Patent Right in U. S. Letters Patent No. 3,044,798".

Respondent filed its Answer to Petitioner's Complaint on December 18, 1964, denying any infringement and after setting forth affirmative defenses that the patent was invalid filed a counterclaim under 28 U. S. C. 2201, and therein stated that "Defendant avers that the patent 3,044,798 set forth in paragraph 5 of the Complaint is invalid because of anticipation and/or lack of invention over the prior art set forth in 'Schedule A' attached and made a part of Defendant's Answer; and are further invalid for the reasons asserted in the Third through the Eleventh Defenses comprising paragraphs 9 to 17 of said Answer, the allegations of which are incorporated in this counterclaim by reference".

At the trial, counsel for Petitioner, in his opening remarks, made the following statement, "There are several claims in this Gerner patent in suit. Only one of these claims is what we will really be talking about, that is

claim 1. We have said in our trial brief particularly claims 1, 4 and 5 because we consider all of these to be infringed by the Defendant, but we will be talking particularly about claim 1, and this will, I hope, reduce the length of time it takes". Counsel for Respondent, at the conclusion of his opening remarks, made the following statement, "I agree with counsel for Plaintiff that we can confine the examination of the patent to claim 1 because that is the broadest claim in the patent and the language in claim 1 will be further repeated in all of the other claims,—the important language".

At the conclusion of the trial the court asked counsel to prepare Proposed Findings of Facts and Conclusions of Law. Counsel for Petitioner submitted findings, the pertinent ones of which are paragraphs 4, 5 and 6 as follows:

"4. The Gerner invention as defined in claim 1 of the Gerner patent is not disclosed in any of the references relied upon by the Defendant, particularly the Ingersoll and Swiss patents, or any combination thereof;

5. The Gerner invention as defined in Claim 1 of the Gerner patent was not obvious at the time of the Gerner invention to one skilled in the art and represents a patentable and highly commercial improvement in the industry;

6. The Gerner patent, and specifically claim 1, is valid."

Counsel for Petitioner submitted proposed Conclusions of Law and stated in paragraphs 5 and 8 thereof the following:

"5. Defendant has infringed claims 1, 4 and 5 of the Gerner patent in suit by its sale of idler arms illustrated at PX-8-A through 8-R.

8. Defendant's counterclaim as to all counts is without merit and shall be dismissed with prejudice."

Respondent's counsel, however, in its proposed finding, paragraph 4, stated the following:

"4. This is an action for infringement of the Gerner patent 3,044,798 and at the opening of the trial on the merits the Plaintiff limited its charge of infringement to claims 1, 4 and 5 with claim 1 being exemplary of the infringement issue."

And in the proposed Conclusions Respondent's counsel made the following statements in paragraphs 2, 3 and 7:

"2. Defendant has discharged its burden of showing non-infringement of claims 1, 4 and 5 of Gerner patent 3,044,798 by its sale of idler arms illustrated in drawing PX-8A through 8R.

3. In view of the prior art not considered by the Patent Office the presumption of validity of the Gerner patent is rebutted and claims 1, 4 and 5 are invalid if construed broadly enough to cover defendant's idler arms.

7. If the Plaintiff contends that the patent claims as issued are to be interpreted in accordance with the claims originally filed and amended, then the patent is invalid by anticipation by the prior art."

Petitioner's reply brief in the District Court concluded with the statements, "That the accused Moog idler arm structure constitutes an infringement of the Gerner patent claim 1; and that the Gerner patent is valid".

It will be noted in Petitioner's Appendix A, page 1a, that the District Court Memorandum contained the following comment: "This is an action for infringement of the Gerner patent, particularly claims 1, 4 and 5 . . ., the Plaintiff relies on claim 1 as being exemplary of the infringement issue". The conclusion reached by the District Court was that "The Gerner patent, when considered with the prior art and particularly that not cited by the Patent

Office is invalid because the combination of old elements is obvious to anyone of ordinary mechanical skill."

(See Petitioner's Appendix A, page 9a.)

The Court of Appeals in its Decision stated "The sole issue for determination upon this appeal is the validity of U. S. patent No. 3,044,798 which issued to Theodore C. Gerner on July 17, 1962 . . . Moog denied infringement and additionally set up as a defense the invalidity of the patent".

(See Petitioner's Petition Appendix B in page 14a.)

As the Court of Appeals stated, the sole issue is the determination of validity or invalidity of U. S. Patent 3,044,798, and nowhere in the record below has Petitioner ever appealed from the District Court's decision that the patent was invalid in toto. Neither has Petitioner clearly asserted that only claims 1, 4 and 5 were to be adjudicated. For example: Following the decision of the Court of Appeals which affirmed the District Court, Petitioner asked for a rehearing "directed specifically to the testimony of Defendant's expert insofar as it conflicts with the testimony of Plaintiff's expert and demonstrable evidence". The Petition for rehearing has not been reproduced by Petitioner in the Appendix to the Petition for Writ of Certiorari. Therefore such missing document is reproduced herein as Appendix I.

DISCUSSION OF QUESTION I.

Petitioner seeks determination of the question "Whether a patent can be adjudicated invalid where only certain of the claims thereof are put in issue".

The courts have recognized that, aside from the private rights of the parties in patent litigation, it is in the public interest that all questions relative to the validity of the claims of a patent should be litigated and determined. In

Kawneer Co. v. Pittsburg Plate Glass Co., 103 F. Supp. 671, 676; 93 U. S. P. Q. 3, 7, it was said:

> "On the other hand, it was held that in view of Rule 41(a), a counterclaim seeking declaratory relief on the issues involved in the main action is redundant and should be stricken. *However, the Supreme Court has now settled the question that in a patent infringement suit, the defendant can by counterclaim seeking a declaratory judgment assert the invalidity of the patent.*"

What Petitioner is attempting to do now is to have a review of the issue of validity of claim 1 under the cloak of an argument that the courts below went too far in declaring all claims of his patent invalid when only claims 1, 4 and 5 were in issue. What actually happened in the District Court is that Petitioner directed the Court's attention to claim 1 as the language thereof expressed the essence of the subject matter of the infringement and was typical of the language in all claims. Respondent did not move to withdraw claims 2, 3, 6 and 7 from the case, thereby in effect conceding that the validity or invalidity of claim 1 would decide the validity or invalidity of all of the claims. **Sterling Aluminum Products, Inc. v. Bohn Aluminum & Brass Corp.**, 298 F. 2d 538, 132 U. S. P. Q. 365 (CA 6—1962).

In a comparable situation in **Lockner Co., Inc. v. Quehl Sign Co.**, 145 (CA 6—1944) F. 2d 932, 934, the court said:

> "In addition, we think the case is squarely controlled by rule 41 (a) (2) of the Federal Rules of Civil Procedure, . . . which provides, 'If a counterclaim has been pleaded by a defendant prior to the service upon him of the plaintiff's motion to dismiss, the action shall not be dismissed against the defendant's objection unless the counterclaim can remain pending for independent adjudication by the court'." See also

2 Barron and Holtzoff, Federal Practice and Procedure, Sec. 913, pp. 623-625.

The Lockner decision was followed in **Oswego Falls Corporation v. American Seal-Kap Corporation,** D. C. E. D. N. Y. —1946, 65 F. Supp. 338, 69 U. S. P. Q. 155.

In view of the above cases, claims of a patent can be adjudicated invalid in toto, regardless of the number of claims that are put in issue, particularly where the alleged infringer by a counterclaim, timely asserted, puts the validity of the entire patent and all its claims in issue. It is Respondent's contention that Petitioner not only cannot raise the issue of adjudication of only certain of the claims in its patent in view of the Answer and Counterclaim, but presents the issue for the first time too late for this Honorable Court to entertain the instant Petition. The decisions of the Supreme Court hold that questions and issues not presented to the lower courts for their decision will not be considered by the Supreme Court. **Walters et al. v. City of St. Louis et al.,** 347 U. S. 231, 233 (2), 74 S. Ct. 505, 507. **Congress of Industrial Organizations et al. v. McAdory, County Solicitor, et al.,** 325 U. S. 472, 477, 65 S. Ct. 1395, 1398.

DISCUSSION OF QUESTION II.

The Petitioner's second Question asks "whether in considering the conditions for patentability under 35 U. S. C. 103, this Court's Opinion in Graham v. John Deere Co., 383 U. S. 1, requires specific determination of (a) the scope and content of the prior art; (b) the difference between such prior art and the patent claims in suit; (c) the level of ordinary skill in the pertinent art."

On the second question it appears from the record, particularly the Memorandum Decision of the District Court below, that the lower court fully considered the scope and content of the prior art. The Memorandum Opinion pre-

sented a patent by patent discussion of the prior art. (See Petitioner's Appendix A, pages 7a and 8a.) In the same Memorandum Decision the differences between the prior art and exemplary claim 1 of the patent were fully set forth (Petitioner's Appendix A, pages 7a and 8a, and 9a). As to the level of ordinary skill in the pertinent art, the District Court's Memorandum Opinion presented a characterization of Petitioner's patent and Respondent's accused devices and then discussed in detail the applicability of the Graham v. John Deere Co. Decision (See Petitioner's Appendix A, pages 2a through 6a).

The answer to Petitioner's second question is obvious that the Supreme Court does require a determination of the scope and content of the prior art, the differences between the prior art and the patent claims, and the level of ordinary skill in the pertinent art. The record below is abundantly clear that the District Court made specific determinations in each of these areas for investigation and consideration.

The Court of Appeals also made its own determination of each of the three points which the Graham v. John Deere decision laid down (See Petitioner's Appendix B, pages 15a through 19a).

DISCUSSION OF PETITIONER'S LEGAL AUTHORITIES.

On the issue of invalidity of certain claims which Petitioner now argues were not before the courts below, Petitioner has cited a case from the Third Circuit Court of Appeals (1962) Chemical Construction v. Jones and Laughlin Steel Corporation, 311 F. 2d 367. Petitioner also cites Ensten v. Simon Ascher Co., 282 U. S. 445.

The "Chemical Construction" case involved a suit for patent infringement in which less than all of the claims

were placed in issue, and those few claims were held invalid. However, the case stands only for the proposition that claims not put in issue by either party are not to be ruled on by the court as any determination as to their validity might be error. The reason for this holding is based on the disclaimer statute, 35 U. S. C. 253 which requires the patent owner to file a disclaimer as to any claims in his patent, less than all of the claims, that are held invalid, if the remainder of the claims are to remain presumably valid.

It is significant that in this case relied on by Petitioner, neither party put in issue all of the claims of the patent. Therein lies the distinction with the case at Bar. Here Petitioner put all of the claims of its patent in issue in the Complaint and Respondent by its counterclaim also placed all of the claims of the Petitioner's patent in issue. Now, after both courts below have held all of the claims invalid, the Petitioner wants to salvage something by belatedly disputing the issue that only certain claims were placed in issue before the courts below. It was held in Hap Corporation v. Heyman Manufacturing Co. (C. A. 1—1962), 311 F. 2d 839, 844, that:

> "Not having disputed the issue of validity below, it (Heyman) cannot do so now in order to obtain a reversal. It is not enough that the record may contain evidence on which appellant may piece together a case". Fleming v. VanDerLoo, 1947, 82 U. S. Appeal D. C. 74, 160 F. 2d 906. It is now too late. Maloney v. Brandt, C. A. 7, 1941—123 F. 2d 779.

Petitioner also relies on Ensten v. Simon Ascher Co., 282 U. S. 445, 51 S. Ct. 207, 1931. In this case Plaintiff Ensten brought suit on his patent and the District Court held claims 1, 3, 4 and 5 valid and claim 2 invalid. Defendant appealed from the holding of validity of claims 1, 3, 4 and 5 but Ensten did not appeal and therefore the validity of claim 2 was not before the Court of Appeals.

Twenty-three months after the original decision, and six months after the mandate went down, Ensten filed a disclaimer as to claim 2. Thereafter Ensten brought suit against the original Defendant on the same patent and on Defendant's Motion to Dismiss for unreasonable delay in disclaiming the invalid claim 2, the motion was sustained (See 13 F. 2d 132). Thus, Ensten stands for the proposition that unreasonable delay in filing a disclaimer in respect of a claim or claims adjudicated invalid is sufficient to hold the remaining unadjudicated claims invalid, also. Obviously, the Ensten decision does not apply to the facts at Bar because Petitioner has not exhausted available remedies and has not allowed appeal times to lapse which seems necessary to make the disclaimer statute applicable.

Petitioner also relies on Graham v. John Deere Co., 383 U. S. 1, 86 S. Ct. 685 (1966). In this decision the court emphasized that 35 U. S. C. 103 placed emphasis on an inquiry as to non-obviousness and not on quality. It pointed out that the inquiry should include the scope and content of the prior art, the differences between prior art and the claims at issue, and the level of ordinary skill. Against this background of inquiry the obviousness is to be determined and the Supreme Court concluded that the Patent Office and the courts must look more intently on the requirements of Section 103. Petitioner has reproduced in Appendix A the decision of the District Court below and in Appendix B the decision of the Eighth Circuit Court of Appeals. The District Court had before it and considered the decision in Graham v. John Deere Co., because that case is cited in the Memorandum Opinion (See page 6a of Appendix A). Therefore, there can be no doubt that due consideration was given to the opinion of the Supreme Court, and there appears to be no ground for stating that the District Court ignored the admonition from the Supreme Court to the courts below to look more intently into the requirements of 35 U. S. C. 103.

The decision handed down by the Eighth Circuit Court of Appeals (Appendix B), page 18a, clearly shows that the trial court's opinion not only reflects an intimate knowledge of the structure and function of the patented device but a strict adherence to the teaching of the Supreme Court in Graham v. John Deere Co.

CONCLUSION.

Respondent's counterclaim in the court below was intended to seek an adjudication of the invalidity of the entire patent and all its claims. There is a public interest in patent litigation to the extent that all questions relative to the validity of the claims of a patent should be litigated and determined. **Sinclair & Carroll Co., Inc. v. Interchemical Corporation,** 325 U. S. 327, 65 S. Ct. 1143. In that case the court said (page 330):

> "There has been a tendency among the lower federal courts in infringement suits to dispose of them where possible on the ground of non-infringement without going into the question of validity of the patent. Irvin v. Buick Motor Co., 88 F. 2d 947, 951 (33 U. S. P. Q. 60, 64); Aero Spark Plug Co. v. B. G. Corp., 130 F. 2d ... (54 U. S. P. Q. 348); Franklin v. Masonite Corp., 132 F. 2d 800 (56 U. S. P. Q. 71). It has come to be recognized, however, that of the two questions, validity has the greater public importance, Cover v. Schwartz, 133 F. 2d 541 (56 U. S. P. Q. 37, 188) and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

This case has involved questions of facts and conclusions of law which the two courts below have unanimously agreed upon. The judgment does not present a "real" conflict with the decisions of the United States Supreme Court or of Courts of Appeal of other circuits. There ap-

pears to be no special or compelling reason for granting the Writ of Certiorari under the Rules and decisions of the Supreme Court.

For the foregoing reasons, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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APPENDIX I.

In the United States Court of Appeals
For the Eighth Circuit.

No. 18,525, Civil.

Theodore C. Gerner, Plaintiff-Appellant,

v.

Moog Industries, Inc., Defendant-Appellee.

Appeal From the United States District Court for the Eastern District of Missouri, Eastern Division.

Petition by Plaintiff-Appellant for Rehearing.

This Court on September 19, 1967, handed down an Opinion which affirmed the District Court decree holding the Gerner patent No. 3,044,798 invalid. Plaintiff-appellant respectfully requests a rehearing because the factual conclusions accepted by this Court therein are clearly erroneous.

I. Summary.

The Court in its Opinion adopted as controlling on the issue of obviousness certain generalizing conclusions postulated by Defendant's expert and attributed to "the witnesses". These conclusions are inconsistent with the

testimony of Plaintiff's expert, have no foundation in engineering design analysis, and are *clearly erroneous* in the face of demonstrable evidence and the copying of Gerner's invention by Defendant.

II. Obviousness.

Initially, the Court's statement that the Moog "ball bearing structures did not lend themselves as well to one particular automobile, the Chevrolet" (Opinion p. 3), implies that the Gerner invention had limited applicability and impact on the automobile industry.[1] This is not the fact. The physical samples of the Moog idler arm in evidence (PX-4, physical; PX-5, physical; PX-6, physical) were only exemplary of an entire Moog line of accused idler arms (R. 26). In fact, at the time of the trial, Defendant had copied the Gerner invention in eighteen different applications, not just one. These eighteen applications are illustrated in the eighteen manufacturing drawings introduced at the trial (PX-8a through 8r).[2]

Presumably, this Court acknowledges as did the lower Court that the Gerner invention satisfies at least two of the requirements set forth by the Supreme Court in *Graham v. John Deere Co.*, 383 U. S. 1, 15 L. Ed. 2d 525 (1966), i. e., utility and novelty. However, this Court concluded that Gerner's new combination was obvious to one of ordinary skill in the art at the time it was made (35 U. S. C. § 103).

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[1] The importance of the idler arm to the proper operation of an automobile is demonstrated by the recent recall by General Motors of 1,330,000 Chevrolets and Pontiacs. See Appendix, p. 5a.

[2] The colloquy at the trial between the District Court and the attorney for Plaintiff with respect to the eighteen drawings introduced as Exhibits 8a through 8r by Plaintiff was not printed in the original record but is included in the Appendix hereto (p. i). This colloquy would have appeared before the statement by the Court receiving Exhibits 1-8 (R. 64).

The Supreme Court in *Graham* acknowledged that difficulties would exist in applying the non-obviousness test, but likened the difficulties to those encountered "in such frames of reference as negligence and scienter" (at 15 L. Ed. 2d 556). However, whereas negligence and scienter invoked the standard of the reasonably prudent man in which category the esteemed judiciary clearly qualifies, the non-obviousness test for patent validity depends upon the state of mind of one skilled in a technical art. The judiciary ordinarily does not so qualify.

Accordingly, in patent litigation under our legal system, it is incumbent upon one unskilled in the art to determine whether or not the subject matter would have been obvious or unobvious to one skilled in the art. The only basis to make such a determination must of necessity be the testimony of the expert witnesses called upon by the parties to define the scope of the prior art, the advancement made thereover by the invention at issue and the character of such advancement. This is particularly so in the complex art of today's sophisticated automobiles.

Only two expert witnesses were called to testify at the trial in this case, Dean Fischer on behalf of Defendant and Homer Smith on behalf of Plaintiff. A careful scrutiny of their testimony reveals a basic divergence and, further, that if Dean Fischer did understand the Gerner invention at the time of trial, he certainly did not project this knowledge into his testimony.

The particular testimony of Professor Fischer in point was specifically noted by this Court:

> all of the structures called for in Gerner Claim 1 are found in the Ingersoll patent and also that the Swiss patent, structure for structure, absolutely responds to the Gerner patent (page 5).

This testimony is blatantly incorrect. It is inconsistent with the testimony of Homer Smith, Plaintiff's expert (R. 124-130, 134).

More specifically, Claim 1 defines as part of the claimed combination *wedging contact* of the wedge means (bearing) with both the "male member *and* the female member". Defendant reluctantly admitted in its Brief to this Court that it is Gerner's three-piece bearing "alone" which is capable of such *wedging contact* (D. Brief 8). By impeccable syllogistic reasoning, neither "all of the structures called for in Gerner Claim 1 are found in the Ingersoll patent" nor does "the Swiss patent, structure for structure, respond(s) to the Gerner patent", because Claim 1 and the Gerner patent require a three-piece bearing (major premise) and neither Ingersoll nor the Swiss patent discloses a three-piece bearing (or, for that matter, any bearing having the *wedging contact* achieved by Gerner's invention) (minor premise).

In view of this inaccuracy in the testimony of Dean Fischer, it seems apparent that he intentionally or unintentionally failed to comprehend the basic innovation of Gerner's invention. Failure of Defendant's expert to appreciate the invention at the time of trial should be overwhelming evidence of unobviousness.

Further in this regard is Fischer's testimony, also noted by this Court, that "if somebody wanted a joint that takes up wear, it would only be necessary to utilize the Swiss disclosure" (Opinion p. 6). However, the record is devoid of any shread of proof that the Swiss disclosure relied upon by Defendant was ever used, and *Defendant itself did not utilize the Swiss disclosure in designing its idler arm.*[3] *Rather, Defendant copied the Gerner design placed on the*

[3] As to the effect of an absence of commercial activity for the prior art, see *Ling-Temco-Vought, Inc. v. Kollman Instrument Corp.*, 372 F. 2d 263, 267 (2nd Cir. 1967), and cases cited therein.

market by Plaintiff's company. In particular, Defendant copied the Gerner three-piece bearing in order to obtain the wedging contact between both the male member and the female housing.

The significance in operation between a solid ring and a three-piece bearing was demonstrated to this Court at oral hearing by means of a simple demonstration. Specifically, a solid ring in the assembly in suit, i. e. an idler arm frame bracket end pivotal connection renders the structure *inoperative* because the ring will not remain rotationally fixed in the female housing due to the absence of the requisite *wedging contact.* The necessity of such non-rotational movement of the bearing in the female housing for an operative idler arm pivotal connection was also admitted by Defendant to this Court (D. Brief 17). On the other hand, Gerner's three-piece wedge means is capable of being rotationally fixed in the female housing while longitudinally moveable in the event of wear, shock or imprecision in manufacture.

The Court's reference to the colored drawings of Gerner, Swiss and Ingersoll (Opinion p. 5) is also revealing because these drawings, in fact, fail to illustrate the significant aspects of the structures illustrated. It is virtually impossible to distinguish the three-piece bearing from the ring bearing when illustrated in vertical cross-section. Therefore, it should have been apparent to this Court why the colored drawings are misleading.

Finally, this Court in its Opinion noted in connection with Gerner's three-section wedge means, "the difference (over the prior art) appears to be in configuration only because the prior art discloses upper and lower wedge means, which *according to the witnesses* perform the same function" (Opinion p. 6) (Emphasis added). To what witnesses the Court has reference is unclear. Certainly Dean Fischer did not so testify because he did not even

appreciate the difference between the three-section wedge means and the solid ring. On the other hand, Homer Smith testified unequivocally that the three-section wedge means did not perform the same function as the solid ring wedge means,

> Q. ——are we going to produce a structure which operates in the same fashion as the structure illustrated in the Gerner patent?
>
> A. No, you would not.
>
> Q. Now, can you explain why not?
>
> A. Well, the structure in the Gerner patent specifically the wedge elements or wedge means which engage the tapered cone not only wedgingly engage the tapered cone or stud, but they also wedgingly engage or are in wedging contact with the internal surface of the bore. Now in the structure of Ingersoll, the rings, I believe they are numbered 8, colored in yellow are actually one piece solid rings and they will have wedging contact, of course, with the blue part which is equivalent to the tapered stud since we have made it rigid with stud 1, but this cannot expand. They could not have wedging contact with the internal surface of the female bore as in the Gerner structure.

Furthermore, this fact was graphically demonstrated to this Court at oral hearing.

Accordingly, the testimony at the trial by the witnesses was not to the effect that the three-section bearing and the solid ring bearing perform the same function, because in fact they cannot. The Gerner combination not only is novel, but also produces a new result by means of the bearing performing a new function.

In view of the above, it is submitted that the Court merely accepted the broad generalizations and conclusions postulated by Defendant through its expert without

analyzing the testimony or inquiring into the inherent inaccuracies it produced in the conclusions adopted by this Court. Inasmuch as there was a clear conflict between the testimony of Defendant's expert and that of Plaintiff's expert, it should be incumbent upon the Court to resolve the inconsistencies and determine which testimony is correct based upon an analysis and interpretation of the technical evidence available.

Such an analysis of the testimony can lead to only one conclusion. The testimony of Dean Fischer demonstrates a misunderstanding of the Gerner invention at the time of trial. *A greater testimonial to the unobviousness of Gerner's advancement in the art is hard to imagine.*

III. Post-Graham Decisions.

While admittedly statistics are ofttimes misleading and with all due respect to this Court, it is appalling that in the ten reported opinions[4] handed down by the Eighth Circuit since the 1966 decisions of the Supreme Court in the *Graham, Calmar* and *Adams* cases,[5] each and every

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[4] Kell-Dot Industries, Inc. v. Graves, 361 F. 2d 25, 149 U. S. P. Q. 717 (8th Cir. 1966), cert. denied 385 U. S. 842; *American Infra-Red Radiant Co. v. Lambert Industries, Inc.*, 360 F. 2d 977, 149 U. S. P. Q. 722 (8th Cir. 1966), cert. denied 385 U. S. 920; *Skee-Trainer, Inc. v. Garelick Mfg. Co.*, 361 F. 2d 895, 150 U. S. P. Q. 7 (8th Cir. 1966); *Piel Manufacturing Company v. George A. Rolfes Co.*, 363 F. 2d 57, 150 U. S. P. Q. 330 (8th Cir. 1966); *Automated Building Components v. Hydro-Air Engineering*, 362 F. 2d 989, 150 U. S. P. Q. 421 (8th Cir. 1966); *Superior Concrete Accessories v. Richmond Screw Anchor Co.*, 369 F. 2d 353, 151 U. S. P. Q. 677 (8th Cir. 1966); *Imperial Stone Cutters, Inc. v. Schwartz*, 370 F. 2d 425, 152 U. S. P. Q. 91 (8th Cir. 1966), cert. denied 386 U. S. 977; *L & A Products, Inc. v. Britt Tech Corporation*, 365 F. 2d 83, 150 U. S. P. Q. 770 (8th Cir. 1966); *Greening Nursery Co. v. J & R Tool & Mfg. Co.*, 376 F. 2d 738, 153 U. S. P. Q. 660 (8th Cir. 1967); *General Mills, Inc. v. Pillsbury Co.*, ... F. 2d ..., 154 U. S. P. Q. 207 (8th Cir. 1967).

[5] *Graham v. John Deere Co.*, 383 U. S. 1, 15 L. Ed. 2d 545 (1966); *United States v. Adams*, 383 U. S. 39, 15 L. Ed. 2d 572 (1966).

patent has been held invalid, invariably on the basis of Section 103. It seems incredible that the Patent Office, as the Government agency possessing the skill in the art and the legislative responsibility to determine obviousness and unobviousness, could have failed in issuing all of the patents considered by the Eighth Circuit in the last nineteen months.

Furthermore, an analysis of the post-Graham decisions from the neighboring Seventh Circuit dealing with patent validity which have been reported to date in the United States Patent Quarterly[6] reveals that almost 50 percent of those patents adjudicated on the question of invention were upheld as valid. Is it possible that the standard of patentability required in the Eighth Circuit is out of step?

IV. Conclusion.

The Supreme Court decision in the *Graham* case relegated secondary considerations to a rather minor role in determining the question of unobviousness. These are not the basic inquiries on the question of obviousness. This was most forcefully brought out in the reversal of the *Calmar* decision originating in this Circuit.

The determination must hinge primarily on the expert testimony adduced. The testimony in this case directed to the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art, demonstrate a clear basis on which to determine that the issuance of the Gerner patent by the Patent Office was proper and that Defendant's attack on validity should not be sustained.

Accordingly, Plaintiff-Appellant respectfully requests a rehearing directed specifically to the testimony of De-

[6] See Appendix, pp. 1a-3a.

fendant's expert insofar as it conflicts with the testimony of Plaintiff's expert and demonstrable evidence.

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